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09/834,851	04/12/2001	Wanqian D. Liu	20683000120	8396	
20350	7590	12/02/2005	EXAMINER		
TOWNSEND AND TOWNSEND AND CREW, LLP				BOVEJA, NAMRATA	
TWO EMBARCADERO CENTER				ART UNIT	
EIGHTH FLOOR				3622	
SAN FRANCISCO, CA 94111-3834				PAPER NUMBER	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/834,851	LIU ET AL.
	Examiner	Art Unit
	Namrata Boveja	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on 26 September 2005.
- 2a)  This action is FINAL. 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 1-21 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-21 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on 12 April 2001 is/are: a)  accepted or b)  objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some \* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/27/00
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_.

## DETAILED ACTION

1. Claims 1-21 are presented for examination.

### Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No.09/834,855. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims recite a

system for promoting products using a world wide web and copending application number 09/834,855 claims recite a method for promoting products using the world wide web. It is obvious that a method needs to be carried out using a system as recited in 09/834,851, and a recitation of such a required system does not make the claims of the present application patentable distinct over the claims of the above mentioned copending patent application. Therefore it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to conceive of and include a system with the method for promoting products using a world wide web as recited in this application in order to implement the recited method of the co-pending application.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-21 are rejected under U.S.C. 103(a) as being unpatentable over Barnett et al (Patent Number 6,336,099 hereinafter Barnett) in view of Eggleston et al (Patent Number 6,061,660 hereinafter Eggleston).

In reference to claim 1, Barnett discloses a central server configured to promote products over a computer network comprising: a processor configured to receive a specification of a promotion for a product from a first computer (col. 4 lines 42-50, col. 6

lines 55-58, col. 8 lines 14-21, and Figure 9), configured to create an electronic incentive in response to the specification (col. 4 lines 59-62, col. 8 lines 17-21), configured to transfer the electronic incentive to an application server (i.e. equivalent to the online service provider in the prior art) across the computer network, the application server coupled to a merchant server (i.e. equivalent to the discount distributor in the prior art) (col. 8 lines 6-13 and Figure 6), configured to receive usage data of the electronic incentive from the application server, the usage data determined in response to a promotion usage condition (col. 7 lines 36-41, col. 10 lines 51-56, and Figure 1) of *an instance of the electronic incentive stored on the application server* (col. 6 lines 58-62 and col. 11 lines 34-44), and configured to generate a report in response to the usage data (col. 7 lines 44-51); a memory coupled to the processor (col. 4 lines 50-54), the memory configured to store the electronic incentive (col. 4 lines 54-59), configured to store the usage data (col. 5 lines 28-34), and configured to store the report (col. 7 lines 36-51); *wherein the instance of the electronic incentive is created and stored in the application server in response a method on a service object stored in the application server being invoked by the merchant server* (col. 12 lines 9-16); wherein the merchant server specifies rendering of the data associated with the electronic incentive (col. 7 lines 36-55) *in response to a query of the instance of the electronic incentive stored on the application server* (col. 12 lines 29-67); and wherein the promotion usage condition is indicated in the application server when a user coupled to the merchant server fulfills *pre-conditions of the instance of the electronic incentive* (col. 6 lines 52-65, col. 12 lines 8-67).

Barnett is silent about the system and method for implementing incentive programs in an object oriented environment. Eggleston teaches the system and method for implementing incentive programs in an object-oriented environment and using C++ and Java programming to create objects (col. 6 lines 53 to col. 7 lines 14, col. 24 lines 56-64, col. 30 lines 10 to col. 34 lines 19, and complete document). It would have been obvious to modify Barnett to include the use of object oriented programming to implement the incentive program because this well known programming approach composed of objects instead of a list of instructions for the computers enables each object to receive messages, process data, and send messages to the other objects. This makes object-oriented programming more flexible and eases the ability to make changes to programs. Additionally, this approach is often simpler to develop and to maintain, lending itself to more direct analysis, coding, and understanding of complex situations and procedures than other programming methods and has been utilized in specifically implementing incentive programs at the time of the applicant's invention.

4. In reference to claim 8, Barnett teaches a method for a merchant server coupled to a client system comprising: a processor configured *invoke an evaluation service object within an application server for one or more promotions, wherein and instance of a promotion is created in the application server in response thereto, configured to query the instance of the promotion object and receiving a description of a promotion from the application server* (col. 5 lines 3-22 and Figure 3), the description including pre-conditions, a user benefit (Figure 3 and 5), and an output representation of the

promotion (col. 8 lines 22-33 and Figure 1); configured to transmit the output representation of the *promotion* to a client system for display to a user (col. 9 lines 59-67); configured to receive a selection of the at least one item (col. 10 lines 1-16), *configured to invoke a savings method in a service object within the application server to determine a savings amount (col. 5 lines 3-23), wherein the savings amount comprises the user benefit from the application server when the selection of the at least one item satisfies the pre-conditions, and configured to indicate that the user is provided with the user benefit (col. 11 lines 24-44 and Figure 5); and a memory coupled to the processor (col. 4 lines 50-54), the memory, configured to store the selection of at least one item (col. 12 lines 35-54).*

Barnett is silent about the system and method for implementing incentive programs in an object oriented environment. Eggleston teaches the system and method for implementing incentive programs in an object-oriented environment and using C++ and Java programming to create objects (col. 6 lines 53 to col. 7 lines 14, col. 24 lines 56-64, col. 30 lines 10 to col. 34 lines 19, and complete document). It would have been obvious to modify Barnett to include the use of object oriented programming to implement the incentive program because this well known programming approach composed of objects instead of a list of instructions for the computers enables each object to receive messages, process data, and send messages to the other objects. This makes object-oriented programming more flexible and eases the ability to make changes to programs. Additionally, this approach is often simpler to develop and to maintain, lending itself to more direct analysis, coding, and

understanding of complex situations and procedures than other programming methods and has been utilized in specifically implementing incentive programs at the time of the applicant's invention.

5. In reference to claims 2 and 9, Barnett teaches the central server wherein the electronic incentive and user benefit comprises an offer selected from a *group consisting of*: cents off (Figure 5), percent discount, price point, buy X get Y free (col. 12 lines 45-54), solution selling, and promotion content.
6. In reference to claims 3 and 10, Barnett teaches the central server and the processor configured to receive the description when the user meets target criteria of the electronic incentive delivery method selected from a group consisting of: non-targeted, targeted category (col. 6 lines 62-65), targeted usage (col. 6 lines 62-65), targeted brand, and targeted market (col. 4 lines 36-40, col. 7 lines 45-51, and Figure 9).
7. In reference to claims 4 and 5, Barnett teaches the central server wherein the electronic incentive comprises a tracking code (col. 7 lines 21-35 and Figure 3) and calendar data selected from the group: effective date, expiration date (Figure 3)
8. In reference to claim 6, Barnett teaches the central server wherein the electronic incentive comprises a network computer address (col. 13 lines 58-67 and Figure 4A).
9. In reference to claim 7, Barnett teaches a central server wherein the usage from the application server comprises data selected from the group: demographic data of the user (col. 6 lines 58-62 and col. 7 lines 62 to col. 8 lines 1), a geographic indicator of the user, a number of products purchased by the user, currency value of products

purchased by the user, a list of products purchased by the user (col. 8 lines 17 to 21), the tracking code (col. 7 lines 21-35 and Figure 3).

10. In reference to claim 11, Barnett teaches the merchant server wherein the pre-conditions are selected from a *group consisting of*: purchase of an item (col. 12 lines 8-52, col. 13 lines 33-38, and Figure 5), purchase of a quantity of an item (Figure 5), purchase of at least two different items (Figure 3).

11. In reference to claim 12, Barnett teaches the merchant server wherein *the evaluation service object on the application server includes a method to determine a category of items for display for the client system* (col. 9 lines 41 to col. 10 lines 16).

12. In reference to claim 13, Barnett teaches the merchant server wherein the evaluation service object evaluates a shopping category associated with the user (col. 7 lines 45-55).

13. In reference to claim 14, Barnett teaches the merchant server wherein the evaluation service object evaluates a shopping cart associated with the user (col. 7 lines 13-55).

14. In reference to claim 15, Barnett teaches an application server comprising of: a processor configured to receive an electronic incentive from a central server (col. 4 lines 42-50, col. 6 lines 55-58, col. 8 lines 14-21, and Figure 9), the electronic incentive including a pre-condition and a benefit (Figure 3 and 5); *configured to create an instance of the electronic incentive in response to an invocation of an evaluation service object to determine electronic incentives for a user by a merchant server* (col. 11 lines 24-44 and Figure 5), configured to receive a query for a description of the instance of

*the electronic incentive from the merchant server (col. 7 lines 36-55 and col. 12 lines 29-54), configured to receive from the merchant server an invocation of an amount of savings method of a service object to determine a savings for the user, wherein when a selection of the one item fulfills the pre-condition (col. 11 lines 24-44, col. 12 lines 45-67, and Figures 5 and 10) of the electronic incentive, the savings comprises the benefit (col. 12 lines 45-54 and Figure 5); a memory coupled to the processor (col. 4 lines 50-54) configured to store the instance of the electronic incentive (col. 4 lines 54-59), and configured to store a record that the instance of the electronic incentive has been used (col. 7 lines 12-20 and lines 36-45).*

Barnett is silent about the system and method for implementing incentive programs in an object oriented environment. Eggleston teaches the system and method for implementing incentive programs in an object-oriented environment and using C++ and Java programming to create objects (col. 6 lines 53 to col. 7 lines 14, col. 24 lines 56-64, col. 30 lines 10 to col. 34 lines 19, and complete document). It would have been obvious to modify Barnett to include the use of object oriented programming to implement the incentive program because this well known programming approach composed of objects instead of a list of instructions for the computers enables each object to receive messages, process data, and send messages to the other objects. This makes object-oriented programming more flexible and eases the ability to make changes to programs. Additionally, this approach is often simpler to develop and to maintain, lending itself to more direct analysis, coding, and understanding of complex situations and procedures than other programming methods

and has been utilized in specifically implementing incentive programs at the time of the applicant's invention.

15. In reference to claim 16, Barnett teaches the application server wherein *the invocation of the evaluation service object includes* a description of a shopping category of a user (col. 7 lines 62 to col. 8 lines 2 and col. 8 lines 8-22).

16. In reference to claim 17 Barnett teaches the application server wherein the *invocation of the evaluation service object includes* an indicator of items previously selected by the user or currently displayed to user (col. 9 lines 29-33 and col. 10 lines 32-47).

17. In reference to claim 18, Barnett teaches the application server wherein the pre-condition comprises purchase of the one item (col. 12 lines 8-52, col. 13 lines 33-38, and Figure 5).

18. In reference to claim 19, Barnett teaches the application server wherein *the invocation of the evaluation service object also includes* an identifier of the user (i.e. user specific data or a barcode) (col. 2-5, col. 9 lines 34-45, col. 10 lines 58 to col. 11 lines 34, and col. 13 lines 58-67).

19. In reference to claim 20, Barnett teaches the application server wherein the processor is also configured to forward *an indication* that the electronic incentive has been used (i.e. selected or printed or sent to a retailer) to a centralized server (col. 6 lines 53-65 and col. 13 lines 30-42).

20. Claim 21 is rejected under U.S.C. 103(a) as being unpatentable over Barnett in view of Eggleston and further in view of Official Notice.

In reference to claim 21, the claim recites the application server wherein the application server and the merchant server are co-located. In reference to claim 21, official notice is taken that it is old and well known to co-locate two servers, since this would involve using less cable for the connection of the two servers and would hence be more cost effective. Furthermore, co-locating the application and merchant servers does not alter the steps that are performed with the two servers when they are not co-located. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include co-location of the application server and the merchant serve to obtain the above-mentioned advantage.

**Response to Arguments**

21. After careful review of Applicant's remarks/arguments filed on 08/31/2005, the Applicant's arguments with respect to claims 1-21 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the specification and to the claims have both been entered and considered.
22. The nonstatutory double patenting rejection is sustained since applicant requested that the provisional rejection be held in abeyance until one of the applications is issued as a patent.
23. In regards to the abstract, the applicant has restated the abstract to fewer than 150 words and in a manner that succinctly describes the invention instead of using the form and legal phraseology used in the patent claims. Furthermore, the applicant's abstract now describes the disclosure sufficiently to assist readers in deciding whether

there is a need for consulting the full patent text for details. Therefore, the restated abstract is now acceptable.

24. Applicant argues that the present application relates to methods and systems for specifying and distributing promotions across a computer network relying upon a unique and novel software architecture and mechanisms of object oriented programming. Since the use of object oriented programming was well known at the time of the Barnett patent as described throughout in the Eggleston patent number 6,061,660, it would have been obvious for Barnett to carry out his invention using this programming environment as well. Furthermore, applicant is not claiming a specific software code or program in this business method application.

25. Applicant argues that in Barnett's invention a user possesses these promotions and therefore may give it to another user to use. First of all in the electronic promotion embodiment of Barnett (col. 11 lines 34-44) the user does not possess a physical discount. Instead, the discount is routed electronically to a retail store where the user is shopping, and the discount data is held in a buffer, pending purchase by the user. In this case, the user can't give the promotion to somebody else, since he will receive the discount when he purchases the matching product at the retail store. Additionally, in one of the other embodiments described in Barnett (col. 13 lines 58 to col. 14 lines 4), when a user requests a transfer of discount data packages via an e-mail Internet address, the user identification number is verified against a list of valid members to ensure the validity of the user. Furthermore, even in the printed discounts, user identity is verified and reported at the time of redemption (col. 5 lines 47-63). Therefore, Barnett

clearly teaches the prevention of giving away of discounts to unauthorized users. Additionally, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the difference between coupon and promotion) are not recited in the rejected claim(s), since the applicant does not claim the difference between a discount and a promotion. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

26. In regards to applicant's arguments regarding claim 1, applicant states that once the promotion data is on the personal computer in Barnett, the online service provider loses control of the promotion. Barnett in fact clearly teaches away from this statement (col. 4 lines 24-30, col. 5 lines 35-46, and col. 12 lines 9-16), since the online service provider can delete promotions and change the value of the promotions after the promotions are downloaded by calling up a programming routine. Applicant also argues that Barnett requires the user to download the promotions, however this is not the case for every embodiment recited in Barnett. Specifically, in the electronic incentive embodiment, (col. 11 lines 34-44) the promotion is not downloaded by the user and is instead routed electronically to a retail store where the user is shopping.

27. In regards to claim 8, applicant argues that a savings method in a service object within the application server determines a savings amount comprising the user benefit when the selection of one item satisfies the pre-condition. Barnett teaches based on demographics responses generating a savings discount when the user selects, prints

and redeems dog food discounts for Brand X, the user will get discounts issued by Brand Y, or will only get low value discounts, since they are already dog food discount users (col. 12 lines 45-54 and Figure 5). As mentioned before, Eggleston teaches the use of object oriented programming for incentive programs and it was well known at the time of Barnett's invention. Therefore, it would have been obvious for Barnett to implement his invention in an object-oriented environment.

28. In reference to claim 15, applicant argues that Barnett does not teach a processor configured to create an instance of the electronic incentive in response to an invocation of an evaluation service object to determine electronic incentives for a user by a merchant server, configured to receive a query for a description of the instance of the electronic incentive from the merchant server, and configured to receive from the merchant server and invocation of an amount of savings method of a service object to determine a savings for the user. Barnett teaches determining an amount of discount that is printed on a promotion (col. 11 lines 24-44 and Figure 5) and determining which users should receive specific promotions and the value of the discounts based on a targeting criteria of the merchant (col. 12 lines 45-67 and Figures 5 and 10). Barnett also teaches receiving a query for a description of the incentive from the merchant server (col. 7 lines 36-55 and col. 12 lines 29-54). As mentioned before, Eggleston teaches the use of object oriented programming for incentive programs and it was well known at the time of Barnett's invention. Therefore, it would have been obvious for Barnett to implement his invention in an object-oriented environment.

29. In reference to the remaining claims 2-7, 9-14, and 16-21, since they are dependent upon claims 1, 8, and 15, respectively, they are also asserted to be rejected for substantially the same reasons as claims 1, 8, and 15 respectively as detailed in the action above.

30. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

**Conclusion**

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Point of Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

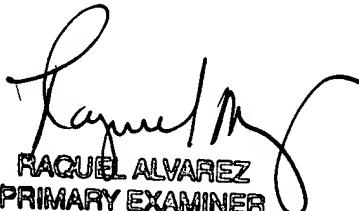
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8105.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

N.B.

November 18<sup>th</sup>, 2005



RAQUEL ALVAREZ  
PRIMARY EXAMINER